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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,561	10/24/2001	James P. Donelan	112692-006	5058
24573	7590	11/30/2004		
BELL, BOYD & LLOYD, LLC				
PO BOX 1135				
CHICAGO, IL 60690-1135				
EXAMINER				
FERNSTROM, KURT				
ART UNIT		PAPER NUMBER		
3714				

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/003,561	<b>Applicant(s)</b> DONELAN, JAMES P.	
	<b>Examiner</b> Kurt Fernstrom	<b>Art Unit</b> 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-20 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff, and further in view of Weinthrop. Hare discloses in column 3, line 55 to column 5, line 45 of the specification a folder comprising a transparent flexible body having an integrally formed erasable writing surface. As a folder, it is inherently bent at one end. This fold represents a bent end capable of removably securing a sheet of paper to the body. Column 3, lines 54-56 and column 7, lines 15-27 in particular discusses the erasable writing characteristics of the transparent member of the folder. A user can write on both sides of the folder. Hare fails to disclose that the folder comprises a dry erase board. Lassoff discloses in column 2, line 64 to column 3, line 14 of the specification a transparent sheet of plastic which can be used as a dry erase board. It would have been obvious to one of ordinary skill in the art to modify the device disclosed by Hare by providing a dry erase surface to the folder for the purpose of allowing a user to more easily remove markings from the sheet, without the using of cleaning chemicals. Hare also fails to disclose a semi-rigid body. However, Lassoff discloses in column 3, lines 7-14 that its transparent dry erase sheet may be laminated

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to a heavier material to provide strength and body to the sheet, thus suggesting the use of a semi-rigid body to provide a stronger, more stable dry erase surface.

Hare further fails to disclose second and third bent ends of the body. Folders having a plurality of bent ends are well known. Weinthrop discloses in Figure 1 one such folder, wherein the body 2 comprises bent sections 12, 7 and 10, which are folded to allow the device to retain sheets of paper. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoff by providing a plurality of bent sections to the body for the purpose of more securely retaining the sheet of paper within the device. The methods of claims 9 and 14 are inherent in the disclosures of the references. The bent ends contact various surfaces and edges of the sheet. With respect to claim 13, the sheet inserted into the device is artwork which is to be copied, and thus has indicia thereon, as discussed in particular at column 5, lines 54-65 of Hare. With respect to claims 14 and 15, Weinthrop discloses in column 1, lines 62-67 that the bending of the sections forms a pocket. With respect to claim 18, the front surface of the folder disclosed by Hare has an erasable surface, as discussed above.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff and Weinthrop, and further in view of Ko. Hare as viewed in combination with Lassoff and Weinthrop discloses all of the limitations of claims 2 and 12 with the exception of the device being flat when shipped. It is known to ship folding items in an unfolded state. Ko discloses in column 1, lines 53-60 of the specification one example of folding binders which are shipped in a flat state. It would have been

obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Lassoﬀ and Weinthrop by providing the device in a flat state when shipping for the purpose of making the device less thick, and thus easier to ship in larger numbers.

***Allowable Subject Matter***

Claims 9-20 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The newly added language to claims 9 and 14 reciting that the body "will not revert to a flat state" overcomes the prior art and places the claims in condition for allowance. This language is interpreted not merely as functional language, which describes the use of the invention, but rather a structural limitation, that the ends remain bent under normal use. This language is supported by the specification, as discussed by applicant, and is not suggested by the prior art. Weinthrop discloses a standard cardboard-type folder, where the body easily reverts to a flat state upon normal manipulation by a user. Conversely, page 5 of the specification recites the use of heat or chemicals to allow a user to fold the device. With this in mind, one of ordinary skill in the relevant art would understand what is meant by the phrase "will not revert to a flat state". Because this feature is not disclosed or suggested in the prior art, and because there is no motivation or suggestion to modify the teachings of the prior art references to include this feature, claims 9 and 14, and all claims dependent therefrom, are allowed.

### ***Response to Arguments***

Applicant's arguments filed on August 5, 2004 with respect to claims 1-8 have been fully considered but they are not persuasive. To be more precise, the arguments are persuasive as far as they go, but do not address all of the grounds of rejection, and do not overcome the prior art rejections.

Upon reviewing the claims and the response, it is acknowledged that "semi-rigid" has a meaning which would be understood by one of ordinary skill in the art, and is not indefinite. It is further acknowledged that "semi-rigid" and "flexible" are not coextensive, and that Hare fails to disclose or suggest a semi-rigid device. However, as noted above and at page 3, lines 15-18 of the previous Office Action, Lassoff discloses a dry erase sheet which is laminated for additional strength and body, thus suggesting a semi-rigid surface. As a result, the combined teachings of the references suggest the invention. The response of August 5, 2004 does not address this rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
November 23, 2004



KURT FERNSTROM  
PRIMARY EXAMINER